

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI OSE

Appeal 2007-0722
Application 09/992,597
Technology Center 2100

Decided: February 28, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and THOMAS A. WALTZ, *Administrative Patent Judges*.

KIMLIN, *Administrative Patent Judge*.

REMAND UNDER 37 C.F.R. § 41.50(a)(1) AND
ORDER UNDER 37 C.F.R. § 41.50(d)

This appeal involves claims 34-37, 40, 41, 43-47, 49-55, 61-65, 73, and 74. The claims stand rejected under 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

The appealed claims are directed to a bicycle shift control device. The device comprises, *inter alia*, a rotatable dial coupled to a base member

and a finger contact projection extending from the rotatable dial in a direction of the rotational axis of the dial. Claim 34 also recites "wherein the finger contact projection protrudes radially inwardly from a radially innermost outer peripheral surface of the dial so that" Appellant submits that "this should be readily apparent from Figs. 13-15" (p. 3 of principal Br., second para.).

Unfortunately, the specific meaning of the claim recitation, when considered in light of Figs. 13-15, is not readily apparent to us. We can see that the finger contact projection (584) is disposed on an outer surface of dial (512), but we fail to perceive how it protrudes radially inwardly from a radially innermost outer peripheral surface of the dial. It is not clear what constitutes the radially innermost outer peripheral surface of the dial from which the finger contact projection protrudes radially inwardly. The language "radially innermost" would seem to indicate the center of a circle from which the radius emanates.

Since the interpretation given to the claim recitation is essential to determining the propriety of the Examiner's § 102 and § 103 rejections, this application is remanded to the Examiner in order to place on record the Examiner's interpretation of the claim language. Also, under the provisions of 37 C.F.R. § 41.50(d), Appellant is hereby ordered to fully explain the plain meaning of the claim recitation, and to point out where the original Specification provides descriptive support for the claim language within the meaning of § 112, first paragraph. Only when the meaning of the claim language at issue is established on this record can it be determined whether Higuchi anticipates claims 34-37, 43-47, 49-52, 73, and 74, and whether the Examiner's rejections under 35 U.S.C. § 103(a) are well founded.

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This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board. Any Supplemental Answer by the Examiner should only be issued after Appellant complies with our Order to explain the meaning of the claim recitation.

REMAND AND ORDER TO EXAMINER

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